

Serial No. 09/960,396

Amendment Dated: February 1, 2007

Reply to Office Action Mailed October 3, 2006

Attorney Docket No. 3036/50289

**REMARKS**

Reconsideration and allowance of the above-identified application are respectfully requested. Claims 1-9 and 11-22 are now pending, wherein claims 1 and 16 are amended, claim 22 is added, and claims 16-20 are withdrawn.

Pages 2-4 of the Office Action state that claims 1-15 and 21 are directed to a first subcombination and claims 16-20 are directed to a second subcombination, and that these subcombinations are disclosed as usable together in a single combination. The Office Action, therefore, holds that claims 16-20 are withdrawn from consideration. Applicants respectfully traverse this restriction requirement.

As set forth in M.P.E.P. § 806.05(d), restriction for subcombinations usable together “is only proper when there would be a serious burden if restriction were not required.” Applicants have added new claim 22, which depends from elected claim 11 and includes similar features to independent claim 16. Because dependent claim 22 must now be searched and examined, there would be no serious burden to examine independent claim 16 using the results of this search. Accordingly, withdrawal of this restriction requirement is respectfully requested.

Claims 1-9, 11-15 and 21 are rejected under 35 U.S.C. § 103(a) as being obvious in view of the combination of U.S. Patent No. 6,675,208 (Rai), U.S. Patent No. 6,477,644 (Turunen) and Dutch Patent No. 1007409 (Prins). This ground of rejection is respectfully traversed.

As an initial matter it is respectfully submitted that the rejection of claims 1-9, 11-15 and 21 is improper because the Office Action has not established a proper *prima facie* case of obviousness. M.P.E.P. § 2143 sets forth the three basic criteria that must be established for a *prima facie* case of obviousness. Specifically, “[t]o establish a *prima facie* case of obviousness...[f]irst, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings... [and f]inally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

The rejection of Applicants' claims 1-9, 11-15 and 21 does not satisfy these two basic criteria of a *prima facie* case of obviousness. Specifically, the Office Action acknowledges that Rai does not disclose a portable communication device having a browser, but instead cites UK Patent Publication No. 2 342 816 to support that this is well known in the art. The header of the rejection of these claims does not rely upon this UK Patent Publication, and it is not clear if the rejection is in fact relying upon this publication. Regardless, the incorporation of a browser into the disclosure of Rai is a modification to the disclosure, and the Office Action has not set forth any motivation for such a modification. Merely because something is well known in the art is not sufficient motivation for one skilled in the art to make such a modification. Hence, this rejection does not satisfy the first basic criteria of a *prima facie* case of obviousness.

Furthermore, the Office Action, without providing any motivation for modifying the prior art relied upon in the rejection as required to satisfy the first basic criteria of a *prima facie* case of obviousness and without citing any prior art as is required to satisfy the third basic criteria of a *prima facie* case of obviousness, states that “it is well known to utilize mobile telephones as modems to communicate data within a wireless network.” Because the Office Action has not provided motivation for this modification or prior art disclosing the feature of this modification, this statement in the Office Action makes clear that the first and third basic elements of a *prima facie* case of obviousness have not been satisfied.

The combination of Rai, Turunen and Prins does not render Applicants' claim 1 unpatentable because the combination does not disclose or suggest all of the elements of this claim. Specifically, the combination does not disclose or suggest the following elements of claim 1:

- a visitor authentication, authorization and accounting (VAAA) server;
- a home authentication, authorization and accounting (HAAA) server;
- a portable computing device with a browser;
- the PIN is encoded and forwarded to the user's mobile telephone and transferred to the browser to authenticate the requested visiting access to the W-LAN;

- the cost of such access is billed to the user's cellular mobile account;
- and
- the requested access is achieved via the user's browser.

It appears that the Office Action relies on element 72 of Rai as disclosing a HAAA server. Rai discloses that this element, however, is a home interworking function (IWF), but does not disclose or suggest that the home IWF is a HAAA server. Instead, Rai discloses that MSC 40 includes accounting and directory servers 48, and that the home MSC includes a registration server. (Col. 6, lines 27-29, and col. 7, lines 51-55). Because Rai discloses different servers for accounting and registration functions, Rai does not disclose or suggest a HAAA as recited in Applicants' claim 1. For similar reasons Rai does not disclose or suggest a VAAA. Turunen and Prins do not remedy this deficiency of Rai. Accordingly, the combination of Rai, Turunen and Prins does not disclose or suggest a HAAA or VAAA as recited in Applicants' claim 1.

As discussed above, the Office Action acknowledges that Rai does not disclose a portable communication device with a browser, but instead states that this is well known in the art by citing, but not relying upon in the rejection, a UK Patent Publication. Moreover, Turunen and Prins each do not disclose or suggest a portable communication device with a browser. Accordingly, the combination of Rai, Turunen and Prins cannot disclose or suggest such.

Therefore, the combination of Rai, Turunen and Prins cannot disclose or suggest that “the requested access is achieved via the user’s browser.”

With regard to the claim element that “the PIN is encoded and forwarded to the user’s mobile telephone and transferred to the browser to authenticate the requested visiting access to the W-LAN” the Office Action acknowledges that Rai and Turunen do not disclose this element, and instead relies upon Prins.

Prins discloses a system in which a user enters a the number of a mobile phone 8 into a terminal 2, and receives a code in the form of an SMS message on mobile phone 8. (Pages 3 and 4). Prins, however, does not disclose a browser, and cannot disclose transferring a PIN to a browser to authenticate the requested visiting access to the W-LAN as recited in Applicants’ claim 1.

To reject the claim element that “the cost of such access is billed to the user’s cellular mobile account” the Office Action cites column 3, lines 5-15 and column 6, lines 32-39 of Rai. Column 3, lines 5-15 of Rai discloses that a mobile end system that is a subscriber to a home network can operate within a foreign network, but does not discuss billing. Column 6, lines 32-39 discloses that an accounting server collects accounting data and sends the data to the service provider’s billing system. It should be recognized that in Applicants’ claim 1 the access that is billed to the user’s *cellular mobile account* is visiting access to a *W-LAN* achieved using the browser of a portable computing device, and not the mobile telephone. Moreover, the user’s cellular mobile account is *for the mobile*

*telephone.* A mere disclosure of billing a home network for access to a foreign network does not disclose or suggest the billing recited in Applicants' claim 1.

Because there are a number of elements of Applicants' claim 1 not disclosed or suggested by the combination of Rai, Turunen and Prins, this combination cannot render claim 1 obvious.

Dependent claims 2-9 and 21 are patentably distinguishable over the combination of Rai, Turunen and Prins at least by virtue of their dependency from claim 1.

Moreover, with regard to claim 7, the combination of Rai, Turunen and Prins does not disclose or suggest that "masking information is randomly derived." The Office Action acknowledges that this is not disclosed by the combination of Rai, Turunen and Prins, but instead merely states, without a citation to a prior art reference, that this is well known. However, without citing a prior art reference, this rejection has not satisfied the third basic criteria of a *prima facie* case of obviousness, and therefore should be withdrawn.

Regarding the rejection of claim 9, the Office Action cites column 1, lines 62-67, column 5, lines 31-39, and column 6, lines 32-39 of Rai as disclosing that "the telephone call from said user is routed to the HAAA through a premium rate call unit." These sections respectively disclose end users paying telephone companies for making telephone calls, wireless service providers being capable of offering wireless packet switched data access services, and collection of

accounting data by an accounting server. These sections do not, however, mention a premium rate call unit, or routing a call to a HAAA via such a call unit. Turunen and Prins do not remedy this deficiency of Rai. Accordingly, the combination of Rai, Turunen and Prins cannot render this claim obvious.

Regarding independent claim 11, the Office Action essentially rejects this claim for the same reasons as claim 1. Claim 11, however, recites different elements from claim 1, such as “transmitting, by a mobile telephone to a visitor authentication, authorization and accounting (VAAA) server, a request for access to the first W-LAN, the request including identity information of a home authentication, authorization and accounting (HAAA) server.” As discussed above, Prins discloses that *user terminal 2* is employed to request that a code be sent to mobile phone 8. Prins does not disclose or suggest a *mobile telephone* sending a request for access to a W-LAN as recited in Applicants’ claim 11. Because the Office Action generally treats claim 11 in the same manner as it treated claim 1, the Office Action has not specifically addressed this claim element. As such, the combination of Rai, Turunen and Prins does not render claim 11 obvious.

Claims 12-15 are patentably distinguishable over the combination of Rai, Turunen and Prins at least by virtue of their dependency from claim 11.

The combination of Rai, Turunen and Prins does not render claim 21 unpatentable because the combination does not disclose or suggest that “the

portable computing device is coupled to the mobile telephone via a wireless link."

To reject this claim the Office Action appears to cite column 5, lines 56-65 of Rai for a wireless link and page 6, lines 8-14 of Prins for the transfer of the PIN. Column 5, lines 56-65 disclose that *external modems* can be attached to a *PC* via a wireless link. In contrast, Applicants' claim 21 recites that a *portable computing device* is coupled to a *mobile telephone* via a wireless link. Prins does not disclose such a wireless link, and cannot remedy this deficiency of Rai.

Because the Office Action has not established a proper *prima facie* case of obviousness and the combination of Rai, Turunen and Prins does not disclose or suggest all of the elements of Applicants' claims 1-9, 11-16 and 21, the rejection of these claims should be withdrawn.

New claim 22 depends from claim 11, and is patentably distinguishable over the current grounds of rejection at least by virtue of its dependency.

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In light of the foregoing remarks, this application should be in condition for allowance, and early passage of this case to issue is respectfully requested. If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #3036/50289).

Respectfully submitted,



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